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3621

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Robert Barra, et al.

Serial No.: 09/771,546

Filed: January 29, 2001

For: **METHOD AND APPARATUS FOR PROVIDING  
SPECIALIZING A SERVICE TO TRANSFER MESSAGES  
OVER A COMMUNICATIONS NETWORK**

Examiner: Backer, Firmin

Art Unit: 3621

Docket No.: P-1 CIP MG

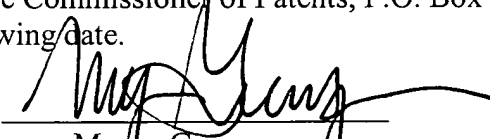
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Dated: February 15, 2007

  
Myron Greenspan

**RESPONSE**

This is in response to Office Action mailed on October 20, 2006 rejecting all claims 34-45 currently of record. For reasons previously received with the Examiner and summarized below, it is respectfully requested that the rejection be withdrawn.

On the basis of previous discussions with the Examiner, applicant submitted a Request for Continued Examination (RCE) on July 31, 2006. Evidently, this submission was filed on August 4, 2006 and entered. On the basis of an Amendment filed

contemporaneously with the RCE the Examiner has evidently withdrawn the previous rejections but indicated, in paragraph 2 on page 2 of the outstanding Office Action that those arguments are now moot in view of new grounds for rejection set forth in paragraphs 3-16.

All of the claims 34-45 stand rejected under 35 USC 103 (a) as being obvious and, therefore, unpatentable over various combinations of references.

The Preliminary Amendment submitted with the RCE amended the Specification by including a cross-reference to a related parent application Serial No. 09/578,756 filed on May 25, 2000 which is currently pending. The cross-reference also mentions a Disclosure Document No. 461519 filed by applicants on September 1, 1999.

In the new rejections, claims 34-45 have been rejected on the basis of one or more combinations of references. The claims of record currently include independent claim 34 and independent claim 41. Both of these claims have been rejected as being obvious on the basis of U.S. Published Application No. 2005/0176451 A1 to Helferich in view of or when combined with U.S. Published Patent Application No. 2001/0007993 to Wu. In rejecting both of these independent claims 35 and 41 the Examiner indicates that Helferich teaches substantially everything recited in these independent claims except maintaining the information in the mail center to be available following receipt of the requested specified services notwithstanding possible deletion of the information from at least one of the sending and receiving computers. For that the Examiner has relied on the Wu Publication, for reasons set forth in paragraphs 5 and 12 of the Office Action.

On October 8, 2007, the undersigned attorney for applicant conducted a telephone conference with Examiner Backer to discuss the new rejections as well as the references

which have been relied upon by the Examiner. As has occurred previously, applicants again traverse these rejections on the grounds that at least one of the references which has been applied by the Examiner are improper references and it is improper to rely on these references since the dates are not sufficiently early to overcome this application's earliest effective filing date.

Initially, it is noted that the Helferich Publication cross-references to a number of previously filed patent applications the earliest one of which is a provisional application filed on March 29, 1999. Another provisional application is dated September 21, 1999. Additionally, the Helferich Publication is a continuation of an application filed on October 6, 2004 which is in turn a continuation of an application filed on September 30, 1999 although it is not clear which portions of Helferich derive from the earlier March 29, 1999 provisional application and which portions derive from the remaining applications, it is noted that applicant's disclosure document filed on September 1, 1999 clearly shows conception prior to all of the Helferich dates with the possible exception of the March 29, 1999 subject matter. It is also respectfully pointed out that applicants can swear in back of Helferich applications with the possible exception of the provisional application filed on March 29, 1999 which has a date which is more than one year prior to applicant's earliest effective filing date of May 25, 2000. The remaining Helferich dates are all less than one year prior to the earliest subject filing date. Therefore, it is respectfully submitted that applicant can swear in back of all of the Helferich applications with the possible exception of the subject matter disclosed in the March 29, 1999 provisional application. However, such "swearing back" or filing of a Declaration under 35 CFR 1.131 is not deemed necessary at this time. The reason for this is that the

remaining references which have been applied by the Examiner and which the Examiner has proposed be combined with the teachings of Helferich are clearly improper references. Thus, for example, the publication to Wu has its earliest effective filing date January 2, 2001 while the Publication No. US2006/0095527 A1 to Malik has as its earlier effective filing date of November 30, 2000. Both the Wu and Malik publications, clearly, have effective filing dates which are subsequent to the earliest effective filing date to which applicants are entitled to, namely May 25, 2000-- even without swearing in back of the Helferich publication.

During the telephone conference with the Examiner, the Examiner has also noted that the subject application is a continuation-in-part (CIP) application of the parent application Serial No. 09/578,756 filed on May 25, 2000. The Examiner has indicated some concern that if the rejected claims rely on the new or added subject matter first filed on January 29, 2001 then Wu and Malik could be valid references that could be used. However, it is respectfully submitted that all of the claims of record recite subject matter contained in the original parent application Serial No. 09/578,756. As discussed with the Examiner, submitted herewith for the Examiner's convenience, is a copy of the parent application Serial No. 09/578,756 which includes Figs. 1-5b which are substantially the same figures as contained in the subject application. Thus, the new matter in the subject CIP application is represented by Figs. 6-17, which illustrate more specific details, although these are not recited in the claims which have been rejected. Thus, a comparison of the language, elements and steps recited in claims 34-45 clearly indicates that all of these were contained in the parent application and, therefore, applicants are entitled to the

earlier effective filing date of May 25, 2000 for everything which is now recited in the claims of record.

Regarding the merits of Helferich, and whether a Rule 131 Declaration is required, the Examiner is respectfully requested to clarify that portion of the rejection. Thus, if the Examiner can clarify as to which portions of Helferich were relied upon by the Examiner, which are entitled to an effective filing date of March 29, 1999 and which portions of the publications are, therefore, entitled to dates of September 30, 1999 and subsequent dates, applicant will be enabled to make a determination as to whether a Rule 131 Affidavit can and/or should be filed to overcome those portions of Helferich entitled to a date later than September 30, 1999. As noted above, however, even if the Examiner only relies on portions of Helferich which have an earlier effective filing date of March 29, 1999 those portions of Helferich cannot be currently and properly be combined with Malik and/or Wu for the aforementioned reasons. Accordingly, it is respectfully submitted that the obviousness rejections currently of record not only fail to be *prima facie* rejections but are improper and should be withdrawn.

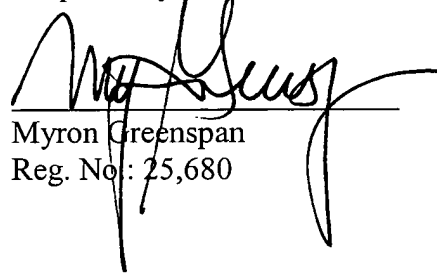
Under the circumstances, and in view of the fact that applicant has already responded a number of times regarding improper references, it is respectfully submitted that this application is now in condition for allowance. Early allowance and issuance is, accordingly, respectfully solicited.

The Commissioner is hereby authorized to charge payment of the fees associated with this communication and during the pendency of this application, such as an extension or issue fee if mistakenly not paid or insufficient funds, and/or any other fee due but not paid by check, etc., or credit any overpayment to Deposit Account No. 10-0100.

Dated: February 15, 2007

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Respectfully submitted,



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